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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,194 07/07/99 BUECHLER

K 244/121

HM12/0524

LYON & LYON LLP  
633 WEST FIFTH STREET 47TH FLOOR  
LOS ANGELES CA 90071-2066

EXAMINER

GABEL, G

ART UNIT	PAPER NUMBER
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1641

DATE MAILED:

05/24/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/349,194

Applicant(s)

Buechler et al.

Examiner

Gail ne R. Gabel

Group Art Unit

1641



☒ Responsive to communication(s) filed on Jul 7, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1 and 55-133 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1 and 55-133 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to immunoassay system for determining a troponin or group of forms in a whole blood, classified in class 436, subclass 501.
  - II. Claims 55-84, 97-101, 107-113, drawn to immunoassay for determining concentration of complexed cardiac troponin I (cTnI) using antibodies specific therefor, classified in class 435, subclass 7.1.
  - III. Claims 85-96, 102-106, 114-133, drawn to immunoassay for determining free and complexed cardiac troponin I (cTnI) using antibodies specific therefor, classified in class 435, subclass 7.92.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions and different effects in that Invention I requires an assay system capable of identifying different individual troponin isoforms using biospecific antibodies and Invention II requires an assay system capable of identifying troponin in a complexed form using antibodies specific therefor.

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Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions and different effects in that Invention I requires an assay system capable of identifying different individual troponin isoforms using biospecific antibodies and Invention II requires an assay system capable of identifying troponin in free and complexed forms using various antibodies specific therefor.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as invention III may be used in assay binding methods to determine rate of interaction and kinetic activity between free and complexed antigens or antibodies in certain derivatized immunosensors. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because the search required for Group I is not required for Group II, and the search for Group II is not required for Group III, restriction for examination purposes as indicated is proper. Literature search for each method is distinct since

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the structural requirements of each invention are different. While searches would be expected to overlap, there is no reason to expect the searches to be coextensive.

4. A telephone call was made to Mr. Mike Whitaker on 4/28/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

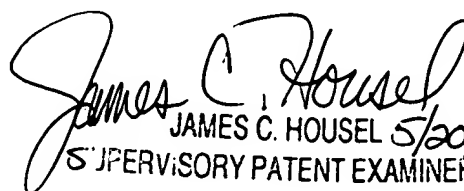
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807.

grg

May 15, 2000

  
JAMES C. HOUSEL 5/20/00  
SUPERVISORY PATENT EXAMINER